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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,606	08/24/2001	Masuyo Horiguchi	PNDF-01114	8991

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WHITHAM, CURTIS & CHRISTOFFERSON, P.C.
11491 SUNSET HILLS ROAD
SUITE 340
RESTON, VA 20190

EXAMINER	
SING, SIMON P	

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/935,606	HORIGUCHI, MASUYO	
	Examiner	Art Unit	
	Simon Sing	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-9 and 11-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-9 and 11-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: The parenthesis "(an interchanging means, hereinafter)" in line 7 is a redundancy to means of interchanging, and should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Nguyen US 5,797,089.

Nguyen discloses a personal communication terminal 10 has independently energized a mobile telephone and a personal digital assistant (PDA) in figures 1 and 2 (column 3, lines 36-67; column 4, lines 1-22). Nguyen teaches means (switch 26) for interchanging a communication mode and a non-communication mode by turning the phone power switch 26 on or off. When the phone power switch 26 is off and PDA power switch 25 is on, an indicator 27 is

lighted for indicating the terminal 10 is in the PDA (non-communication) mode. Switches 25 and 26 are controlling means for stopping the personal communication terminal's telephone function and lighting up the PDA indicator. The PDA indication 27 is situated at a position (figure 2) easily seen by persons other than a user when the terminal 10 is opened.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi Japanese Patent publication Number 11-308163 in view of Korycan US 5,950,139.

3.1 Regarding claim 1, Atsushi discloses a portable telephone in figures 1 and 2, Atsushi teaches a stop key 6d, which when pressed, a central processing unit 4 disconnects DC power to radio units 2 and 3, disabling its telephone function, and a non-communicative mode indicator (figure 5) appears on display unit 7 (figure 4) (section 0018-036). Atsushi teaches that central processing unit 4 indicates the non-communicative mode in the display unit 7, but fails to teach indicating the non-communicative mode by lighting a lamp.

However, Korycan discloses a radiotelephone in figures 1-5. Korycan teaches that an indicators, such as a signal strength indicator, normally appears in a display unit can be replaced by LED lamps for better viewing (column 1, lines 11-18, 57-67; column 2, lines 16-23). The LED lamps are easily seen by persons other than a user when the radiotelephone is laying face up.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Atsushi's reference with the teaching of Korycan, so that the non-communicative mode indicator in the display unit 7 would have been replaced by a lamp, located on the housing of the portable telephone, because replacing the non-communicative mode indicator in the display with a LED lamp on the housing would have provided a better viewing by a user and others sine a LED lamp was much brighter than a LCD display, and replacing the non-communicative indicator in a display with a LED lamp on the housing would have been a design choice, since it did not alter the functionality of Atsushi's.

3.2 Regarding claim 2, as discussed in claim 1, Atsushi teaches a stop key 6d for disabling radio units 2 and 3.

3.3 Regarding claim 3, as discussed in claim 1, the lamp lights up continuously in the non-communicative mode.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi Japanese Patent publication Number 11-308163 in view of Korycan US 5,950,139 and further in view of Delarminat et al. US 6,262,686 and further in view of Ishihara US 6,167,288.

The Atsushi reference, modified by Korycan, teaches lighting up a LED lamp when the portable telephone in the non-communication mode, but fails to teach that the LED lamp is situated on an antenna and notifies a reception of a radio wave.

However, Delarminat discloses an antenna for a cellular phone in figure 1 (column 1, lines 7-10, 62-65). Delarminat teaches that the antenna comprises a LED 9 (column 1, lines 62-65; column 2, lines 37-40).

In addition, Ishihara discloses a portable telephone set with a LED 2, indicating whether the portable telephone set is for communications or for non-communications by using different colors, or continuous lighting Vs. flashing (figures 1-3; column 1, lines 16-26; column 6, lines 21-26).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Atsushi's reference, which was modified by Korycan, with the teachings of Delarminat and Ishihara, so that the non-communicative mode indicator would have been situated on an antenna and would have been able to notify a user of reception of radio waves by changing its color or by flashing, because situating the LED lamp on an antenna would have made it more noticeable no matter how the portable telephone was placed, and lighting up the LED in another color or by flashing would have

notified a user that the portable telephone was in a communicative mode ready to place or receive a phone call.

5. Claims 6-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi Japanese Patent publication Number 11-308163 in view of Korycan US 5,950,139 and further in view of Nonogaki US 6,625,478.

5.1 Regarding claim 6, the Atsushi's reference, modified by Korycan, teaches disabling the portable telephone's radio unit, but fails to teach urging a user to choose either a communicative mode or non-communicative mode.

However, Nonogaki discloses a wireless telephone in figure 1. The wireless telephone has three operation modes, AV mode (non-communicative mode), telephone/AV mode and telephone mode (communicative mode) (Abstract; column 6, lines 1-13). Nonogaki teaches that in a stand-by state, power to all modules (VA module 200, telephone module 300 and common module (including display) 400) are off except power management controller 101 (column 8, lines 39-49), and when power switch K1 is pressed, the device is turned-on and displays an operation mode, urging a user to confirm by pressing power switch K2, the user may press K2 to select the operation mode displayed, or press K1 again to change the operation mode (column 9, lines 1-22, 41-59). Nonogaki also teaches warning a user when a telephone mode (or telephone/AV mode) is waiting to be selected (column 9, lines 41-59).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Atsushi's reference, which was modified by Korycan, with the teaching of Nonogaki, so that a display would have urged a user to decide an operation mode, such as a communicative mode or a non-communicative mode, because such a modification would have provide a warning message to a user to turn off the radio unit in case said portable telephone was power-up in a restricted area.

5.2 Regarding claim 7, Atsushi discloses a portable telephone in figures 1 and 2, Atsushi teaches a stop key 6d, which when pressed, a central processing unit 4 disconnects DC power to radio units 2 and 3, disabling its telephone function, and a non-communicative mode indicator (figure 5) appears on display unit 7 (figure 4) (section 0018-036). Atsushi teaches that central processing unit 4 indicates the non-communicative mode in the display unit 7, but fails to teach indicating the non-communicative mode by lighting a lamp, and urging a user to choose a communicative mode or a non-communicative mode when power up.

However, Korycan discloses a radiotelephone in figures 1-5. Korycan teaches that an indicators, such as a signal strength indicator, normally appears in a display unit can be replaced by LED lamps for better viewing (column 1, lines 11-18, 57-67; column 2, lines 16-23). The LED lamps are easily seen by persons other than a user when the radiotelephone is lying face up.

In addition, Nonogaki discloses a wireless telephone in figure 1. The wireless telephone has three operation modes, AV mode (non-communicative

mode), telephone/AV mode and telephone mode (communicative mode) (Abstract; column 6, lines 1-13). Nonogaki teaches that in a stand-by state, power to all modules (VA module 200, telephone module 300 and common module (including display) 400) are off except power management controller 101 (column 8, lines 39-49), and when power switch K1 is pressed, the device is turned-on and displays an operation mode, urging a user to confirm by pressing power switch K2, the user may press K2 to select the operation mode displayed, or press K1 again to change the operation mode (column 9, lines 1-22, 41-59). Nonogaki also teaches displaying a warning message when a telephone mode (or telephone/AV mode) is selected (column 9, lines 41-59).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Atsushi's reference with the teachings of Korycan and Nonogaki, so that the non-communicative mode indicator in the display unit 7 would have been replaced by a lamp, located on the housing of the portable telephone, and the display unit 7 would have urged a user to decide an operation mode, such as a communicative mode or a non-communicative mode, because replacing the non-communicative mode indicator in the display with a LED lamp on the housing would have provided a better viewing by a user and others sine a LED lamp was much brighter than a LCD display, and replacing the non-communicative indicator in a display with a LED lamp on the housing would have been a design choice, since it did not alter the functionality of Atsushi's, and urging a user to choose an operating mode would

have provide a warning message to a user to turn off the radio unit in case said portable telephone was power-up in a restricted area.

5.3 Regarding claim 8, the Atsushi's teaches using a switch 6d for disabling the radio units 2 and 3and replacing switch 6d with a touch screen switch would have been a design choice since it just replaced one type of switch (mechanical) with another type (electrical) and did would not have changed the functionality of the modified Atsuahi's portable telephone.

5.4 Regarding claim 9, as discussed in claim 7, the LED lamp lights up continuously in the non-communicative mode.

5.5 Regarding claim 12, a portable telephone inherently has key-tone on/off feature selectable through a menu.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi Japanese Patent publication Number 11-308163 in view of Korycan US 5,950,139 and further in view of Nonogaki US 6,625,478 and further in view of Delarminat et al. US 6,262,686 and further in view of Ishihara US 6,167,288.

The Atsushi reference, modified by Korycan and Nonogaki, teaches lighting up a LED lamp when the portable telephone in the non-communication

mode, but fails to teach that the LED lamp is situated on an antenna and notifies a reception of a radio wave.

However, Delarminat discloses an antenna for a cellular phone in figure 1 (column 1, lines 7-10, 62-65). Delarminat teaches that the antenna comprises a LED 9 (column 1, lines 62-65; column 2, lines 37-40).

In addition, Ishihara discloses a portable telephone set with a LED 2, indicating whether the portable telephone set is for communications or for non-communications by using different colors, or continuous lighting Vs. flashing (figures 1-3; column 1, lines 16-26; column 6, lines 21-26).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Atsushi's reference, which was modified by Korycan and Nonogaki, with the teachings of Delarminat and Ishihara, so that the non-communicative mode indicator would have been situated on an antenna and would have been able to notify a user of reception of radio waves by changing its color or by flashing, because situating the LED lamp on an antenna would have made it more noticeable no matter how the portable telephone was placed, and lighting up the LED in another color or by flashing would have notified a user that the portable telephone was in a communicative mode ready to place or receive a phone call.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi Japanese Patent publication Number 11-308163 in view of Korycan US 5,950,139 and further in view of Delarminat et al. US 6,262,686.

The Atsushi reference, modified by Korycan, teaches lighting up a LED lamp when the portable telephone in the non-communication mode, but fails to teach that the LED lamp is situated on an antenna.

However, Delarminat discloses an antenna for a cellular phone in figure 1 (column 1, lines 7-10, 62-65). Delarminat teaches that the antenna comprises a LED 9 (column 1, lines 62-65; column 2, lines 37-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Atsushi's reference, which was modified by Korycan, with the teaching of Delarminat, so that the non-communicative mode indicator would have been situated on an antenna, because situating the LED lamp on an antenna would have made it more noticeable no matter how the portable telephone was placed.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi Japanese Patent publication Number 11-308163 in view of Korycan US 5,950,139 and further in view of Nonogaki US 6,625,478 and further in view of Delarminat et al. US 6,262,686.

The Atsushi reference, modified by Korycan and Nonogaki, teaches lighting up a LED lamp when the portable telephone in the non-communication mode, but fails to teach that the LED lamp is situated on an antenna.

However, Delarminat discloses an antenna for a cellular phone in figure 1 (column 1, lines 7-10, 62-65). Delarminat teaches that the antenna comprises a LED 9 (column 1, lines 62-65; column 2, lines 37-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Atsushi's reference, which was modified by Korycan and Nonogaki, with the teaching of Delarminat, so that the non-communicative mode indicator would have been situated on an antenna, because situating the LED lamp on an antenna would have made it more noticeable no matter how the portable telephone was placed.

Response to Arguments

9. Applicant's arguments filed on 07/19/2004 regarding claims 1 and 7 have been fully considered but they are not persuasive.

The applicant emphasizes that a non-communication mode lamp is easily seen by persons other than a user, and argues that LEDs on Korycan's radiophone are not easily seen by others when the radiophone is in use and is pressed to a user's ear. However, when the radiophone is in use, the radiophone is clearly in a communication mode, and whether a non-communication mode LED (which is off) of the modified Atsushi reference can be seen by others or not, is meaningless. When the radiotelephone is in a con-communication mode, the non-communication mode LED, situated on the lower front panel of the radiophone as taught by Korycan, is on and is easily seen by

others when the radiotelephone is held by a strap, or lying face-up on a surface (such as on a table top).

10. Applicant's arguments with respect to claims 5 and 11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

S.S.

10/12/2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600